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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,842	07/09/2001	Minoru Terano	2001-0466A	7492

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EXAMINER

TESKIN, FRED M

ART UNIT

PAPER NUMBER


1713

DATE MAILED: 12/06/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/807,842	Applicant(s) Terano, et al.	
Examiner Fred Teskin	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-27 is/are allowed.
- 6) ☒ Claim(s) 1-3, 11-13, and 18-20 is/are rejected.
- 7) ☒ Claim(s) 4-10, 14-17, 21-24, and 28-31 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>7, 8</u> | 6) <input type="checkbox"/> Other: |

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1. The preliminary amendment of 19 April 2001 has been entered. Claims 1-31 are currently pending and under examination.

2. Receipt is acknowledged of papers submitted under 35 U.S.C. § 371, which papers have been placed of record in the file.

3. This application claims benefit to international application No. PCT/JP99/05769 filed on 19 October 1999. Applications that are filed on or after November 29, 2000, and that claim benefit to an earlier-filed international application must include in the first sentence of the specification an indication of whether the international application was published in English under PCT Article 21(2) (regardless of whether the benefit for such application is claimed in an application data sheet). See 37 CFR 1.78(a)(2). The indication, as required by 37 CFR 1.78(a)(2), is missing from the cross-reference information provided by the aforementioned preliminary amendment. Applicant must supply the missing indication as an amendment to the specification in the reply to this Office action.

4. Claims 4-10, 14-17, 21-24 and 28-31 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See

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MPEP § 608.01(n). Said claims each depend from at least one other multiple dependent claim. Accordingly, claims 4-10, 14-17, 21-24 and 28-31 have not been further treated on the merits.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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7. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 11-13 and 18-20 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Terano et al 6211300 ("Terano").

Terano exemplifies propylene-ethylene block copolymer compositions (E) which contain an A-B type block copolymer (C) of polypropylene (A) and an ethylene-propylene random copolymer (B) and a propylene polymer (D), and wherein the content of said copolymer segment and the total ethylene content [(C) plus (D)] meet the corresponding parameters of claim 1. In addition, Terano states that the segment (B) is chemically bonded to the polypropylene segment (A), per characteristic (a) of claims 1 and 18, and describes a procedure for synthesizing the (A) and (B) segments which corresponds to that recited as characteristic (b) of

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said claims. See column 2, lines 41-44; Examples 1-13 and Tables 1-5.

In addition, the total ethylene content of the polypropylene (A) and ethylene-propylene random copolymer (B) segments of the exemplified block copolymers falls within the weight % range specified in claim 18 for total ethylene content of polypropylene-b-poly(ethylene-co-propylene) (see, e.g., (B) segment ethylene content given for Examples 1-3 in Table 1 of Terano).

As to the claimed parameters of M_w , M_w/M_n and xylene-soluble component, Terano does not report these properties for the block copolymer compositions described therein.

Nevertheless, in view of the identity of both block copolymer composition and synthesis procedure, examiner has reasonable basis to believe the disclosed compositions are same as, or only slightly different from, applicants' block copolymer and resin as claimed.

Since this situation involves 102/103 rejection where the property or characteristic relied upon for patentability may be inherent in the prior art [on this record, the Terano patent qualifies as § 102(e) prior art], and since the Office obviously does not have facilities to make and test claimed and prior art products, the burden properly shifts to applicants to show that the property or characteristic recited in the claims represents an unobvious difference. *In re Best*, 195 USPQ 430 (CCPA 1977).

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9. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Muller et al and McCullough, Jr. et al are cited to show analogous art; i.e., art relating to, respectively, polypropylene impact copolymer compositions and propylene/ethylene block copolymers, both characterized by improved resistance to stress whitening.

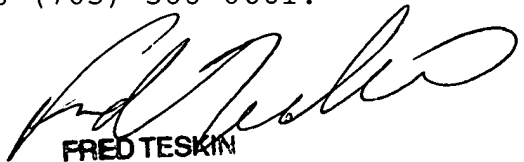
10. Claims 25-27 are free of the prior art of record.

11. Any inquiry concerning this communication should be directed to Examiner F. M. Teskin whose telephone number is (703) 308-2456.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The appropriate fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 (non-after finals) and (703) 872-9311 (after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

FMTeskin/11-30-02


FRED TESKIN
PRIMARY EXAMINER
1713